

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASER YACOOB

Appeal No. 2001-0041
Application No. 08/661,899

HEARD: FEBRUARY 5, 2002

Before RUGGIERO, LALL, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 19, 26-29, 33-35, and 40-45, which are all the claims remaining in the application.

We affirm-in-part, and enter a new ground of rejection in accordance with 37 CFR § 1.196(b).

.

BACKGROUND

The disclosed invention is directed to a data card which contains data relevant to servicing and maintenance of an associated machine, and a method of using such a card. Claim 19 is reproduced below.

19. A machine maintenance data card for recording machine maintenance events said machine maintenance data card comprising:

machine identification data files identifying at least one specific machine, said machine identification data files being write protectable, thereby selectively preventing said machine identification data files from being altered;

maintenance event data files containing a permanent history of maintenance event information for each said at least one specific machine, said maintenance event data files being write-once, read-many;

maintenance scheduling files identifying regularly scheduled maintenance for said machine;

entity identification data files which identify a specific entity and a relationship of said specific entity to said at least one specific machine, said entity identification data files being write privileged, thereby permitting selective writing to said entity identification files; and

maintenance scheduling means for indicating whether regularly scheduled maintenance has been performed on said at least one specific machine responsive to said permanent history.

The examiner relies on the following references:

McGrath	4,159,531	Jun. 26, 1979
Rovin	5,049,728	Sep. 17, 1991
Stewart et al. (Stewart)	5,058,044	Oct. 15, 1991
Ryan	5,359,522	Oct. 25, 1994
Eisenmann	5,459,304	Oct. 17, 1995
		(filed Sep. 13, 1994)

Appeal No. 2001-0041
Application No. 08/661,899

Claims 19, 26-28, 40, and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over McGrath and Eisenmann.

Claims 29, 33-35, and 42-45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ryan, Rovin, and Stewart.

We refer to the Final Rejection (mailed Jul. 28, 1999) and the Examiner's Answer (mailed Mar. 1, 2000) for a statement of the examiner's position and to the Brief (filed Dec. 23, 1999) and the Reply Brief (filed Apr. 28, 2000) for appellant's position with respect to the claims which stand rejected.

OPINION

Claims 19, 26-28, 40, 41

We must reverse, pro forma, the section 103 rejection of claims 19, 26-28, 40, and 41 because we consider the scope of the claims to be indefinite. If certain claim language is not understood, then any attempt to apply art against that claim can only be based on speculation. Rejections of claims over prior art should not be based on speculation as to the meaning of terms employed and assumptions as to the scope of the claims. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We enter a new ground of rejection against the claims under 37 CFR § 1.196(b), infra.

Claims 29, 35

Appellant groups claims 29 and 35 together (Brief at 4), and presents arguments for the group at pages 15 through 17. However, appellant alleges deficiencies in individual references which is, at best, only a partial response to the rejection applied. Nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)).

Appellant does not contest the examiner's finding of motivation for combining the prior art. Appellant's arguments presented are, in the main, more specific than the broad requirements of claims 29 and 35, and thus not commensurate in scope with the subject matter claimed.

Appellant appears to presume that the claims require a machine "verification" of regularly scheduled maintenance. However, claim 29 recites, "determining from said permanent history if said regularly scheduled event was performed at said time indicated in said indicating step." Claim 35 recites, "determining from said permanent history if said one regularly scheduled event was performed at said time indicated in said indicating step." Neither claim distinguishes over a human being doing the "determining" -- i.e., the "verification."

Stewart discloses, particularly at column 7, automated functions for data collection and processing relevant to maintenance. Stewart describes the system as

eliminating any need for the manual inputting of data, with sensor data made available to the host computer 32 (Fig. 1) for updating databases for service records.

Additionally, “[t]otal mileage can be checked against a bench mark mileage recorded in a memory of the main host computer (32) for the purpose of scheduling periodic maintenance such as engine tune-ups and the like.” Stewart at col. 7, ll. 39-43. Read in context, Stewart thus suggests an automated indication of at least one “regularly scheduled event” within the meaning of the “indicating” steps of claims 29 and 35.

The section of Stewart does not disclose any sort of automated determination regarding whether a maintenance event was performed at the time indicated in the indicating step. However, Stewart at least suggests human “determination” of whether or not a regularly scheduled maintenance event was performed at the time indicated. All the information necessary for making such a determination is stored in the database maintained by the main computer. The printed service record 32b (Fig. 1) would be expected to have some indication of past maintenance, rather than simply a statement of maintenance that may be presently required. For example, Stewart at least suggests that a report of periodic maintenance, such as the last engine tune-up of the relevant vehicle, would form part of a printed service record. The claims do not distinguish over human “verification” that, for example, the vehicle received the engine tune-up at the time indicated by the system. The “indicating” and the “determining” steps of claims 29 and 35 require no more.

Appellant's arguments that are commensurate in scope with claims 29 and 35 -- that is, those that speak to the language and actual requirements of the claims -- thus do not persuade us of error in the rejection over the combination of references applied. We therefore sustain the section 103 rejection of claims 29 and 35 over Ryan, Rovin, and Stewart. We have considered all of appellant's arguments, but arguments not relied upon are deemed waived. See 37 CFR § 1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.")

Claims 42-45

Appellant groups claims 42-45 together, and advances arguments on their behalf at pages 13 through 15 of the Brief. We select claim 42 as representative of the subject matter. See 37 CFR § 1.192(c)(7) ("For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone....").

Claim 42 recites that the regularly scheduled event is a "regulated event mandated" by a list of alternative entities. We agree with the examiner's position, as set forth at pages 7 and 8 of the Answer. The fact that governmental requirement of regularly scheduled events with respect to motor vehicles, such as periodic inspections of vehicle systems, is so widely known that official notice may be taken. Appellant has

not challenged the fact, or otherwise required that evidence of such governmental mandates be added to the record. Such events would form part of maintenance data with respect to a vehicle.

Further, we note that one of the entities listed in the alternative in claim 42 is the “owner” who is “concerned with the performance, deployment, or operation of said machine.” The claim thus requires no more than the owner of the vehicle in a rental fleet (Stewart at col. 7) mandating maintenance of the vehicle, such as periodic engine tune-ups.

Since we are unconvinced that subject matter within the scope of the claims presented is nonobvious over the applied combination of Ryan, Rovin, and Stewart, we sustain the section 103 rejection of claims 42 through 45.

Claims 33, 34

We select claim 33 as representative of the subject matter, and consider appellant’s arguments (Brief at 17-18). Claim 33 further limits the “recording step” as being performed “by a service providing entity that is not said specific entity.” The “specific entity” is the entity identified in “entity identification data files” recited in base claim 29. The “recording step” of claim 33 refers to the step of “recording a permanent history of event information on said data card” in the base claim.

The Stewart reference, as we have previously noted with respect to base claim 29, discloses automated functions for data collection and processing relevant to

maintenance. Since the recording of maintenance data is automated, the “recording step” is performed by a service providing entity that is not the “specific entity” associated with the vehicle, such as the owner of the vehicle. We thus sustain the section 103 rejection of claims 33 and 34 as unpatentable over the combination of Ryan, Rovin, and Stewart.

New Ground of Rejection -- 37 CFR § 1.196(b)

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 1.196(b): Claims 19, 26-28, 40, and 41 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 19 is drawn to a “machine maintenance data card” comprising, inter alia, “maintenance scheduling means for indicating whether regularly scheduled maintenance has been performed on said at least one specific machine responsive to said permanent history.” The “permanent history” is maintained in “maintenance event data files.”

Appellant’s “Summary of Invention” in the Brief does not explain what structure in the specification corresponds to the claimed “maintenance scheduling means.” Cf. 37 CFR § 1.192(c)(5) [“Appellant's brief.”] “Summary of invention. A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the

specification by page and line number, and to the drawing, if any, by reference characters.”

Since appellant claims a “data card” (e.g., Fig. 1, element 1010), the “maintenance scheduling means” must refer to data on the card. However, we do not find an entry on any of the disclosed embodiments of the card that performs the function specified by the claim 19 “means.” Additionally, it is unclear how data per se may be in any sense “responsive” to other data per se -- i.e., responsive to “a permanent history of maintenance event information.”

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Lack of any structure in the disclosure corresponding to the “means” indicates that the claims fail to pass muster under 35 U.S.C. § 112, second paragraph. See, e.g., Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381-82, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999); In re Dossel, 115 F.3d 942, 944-46, 42 USPQ2d 1881, 1883-85 (Fed. Cir. 1997). We do not find any structure disclosed which may correspond to the claimed “maintenance scheduling means.”

Instant claim 40 sets forth, in a data card, “regulatory compliance scheduling means for indicating whether regulatory compliance events have been performed on said at least one specific machine responsive to said permanent history.” We do not find any structure disclosed which may correspond to the claimed “regulatory compliance scheduling means.” Moreover, it is unclear how data per se -- the “means

for indicating” -- may be in any sense “responsive” to data per se -- responsive to a “permanent history of maintenance event information.”

Claims 26-28 incorporate the limitations of claim 19, and claim 41 incorporates the limitations of claim 40. We therefore conclude that claims 19, 26-28, 40, and 41 fail to reasonably apprise those of skill in the art of their scope, and hold that the claims fail to pass muster under 35 U.S.C. § 112, second paragraph.

CONCLUSION

The rejection of claims 29, 33-35, and 42-45 under 35 U.S.C. § 103 as being unpatentable over Ryan, Rovin, and Stewart is affirmed.

The rejection of claims 19, 26-28, 40, and 41 under 35 U.S.C. § 103 as being unpatentable over McGrath and Eisenmann is reversed.

Claims 19, 26-28, 40, and 41 are newly rejected by us under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

Appeal No. 2001-0041
Application No. 08/661,899

(1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 2001-0041
Application No. 08/661,899

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART -- 37 CFR § 1.196(b)

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

Appeal No. 2001-0041
Application No. 08/661,899

WHITHAM CURTIS
WHITHAM & MCGINN
RESTON INTERNATIONAL CENTER
11800 SUNRISE VALLEY DR SUITE 900
RESTON , VA 22091